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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/339,325	06/23/1999	YOAV SHOHAM	003660.P001X	2458

7590 08/17/2005

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EXAMINER
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MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/339,325

Applicant(s)

SHOHAM ET AL.

Examiner

James W. Myhre

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-13 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-13 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The after-final amendment filed on July 14, 2005 is sufficient to overcome the rejection of claims 1-7 and 15-21 in view of the Friedland(6,449,601), Tilfors (6,405,180), and Ferstenberg (5,873,071) references by canceling the rejected claims. The amendment canceled Claims 1-7 and 15-21. Claims 8, 14, and 23 were previously canceled. Therefore, the currently pending claims considered below are Claims 9-13 and 22.

### ***Double Patenting***

2. The Terminal Disclosure filed on November 29, 2004 complies with 35 U.S.C. 2563 and 37 C.F.R. 1.321, 3.73, and 1.20(d) and the Examiner hereby withdraws the rejection of Claim 22 in paragraphs 3 and 4 of the March 11, 2005 Office Action.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 9-13 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Woolston (5,845,265).

Claim 22: Woolston discloses a system for conducting auctions, comprising:

a. a market specification console (posting terminal 700) which receives selection of market protocols including trading primitives from a user to dictate the behavior of the auction system (col 4, lines 10-37; col 10, lines 3-18; and col 15, line 23 – col 16, line 58); and

b. a auction server (market maker computer 800) which receives the marker protocol and trading primitives from the market specification console through a network connection and implements the auction (col 14, lines 51-63).

Claim 9: Woolston discloses a system for conducting auctions as in Claim 22 above, and further discloses the marker specification console contains user-modifiable rules (col 5, line 48 – col 6, line 9 and col 17, lines 1-12).

Claim 10: Woolston discloses a system for conducting auctions as in Claim 9 above, and further discloses wherein the rules comprise at least one market protocol (col 15, line 23 – col 16, line 58).

Claim 11: Woolston discloses a system for conducting auctions as in Claim 9 above, and further discloses the market specification console includes a graphical user interface (GUI) to configure the market protocol (Figure 13).

Claim 12: Woolston discloses a system for conducting auctions as in Claim 11 above, and further discloses the market protocol is displayed in parameterized form on the GUI (Figure 13).

Claim 13: Woolston discloses a system for conducting auctions as in Claim 11 above, and further discloses the user defines arbitrary market protocols via the GUI (the user in Woolston uses the GUI to enter all of the selections pertaining to the auction when setting up the auction for posting to the auction server)(Figure 13).

### ***Response to Arguments***

5. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Ausubel (5,905,975) discloses a system for conducting an auction over a network

using a GUI on a marketing specification computer (bidder's computer) and auctioneer's server to conduct a plurality of market protocols using rules selected by the user.

b. Ausubel (6,026,383) discloses a system for conducting auctions over a network using a GUI on the bidders' computers and a bidding information processor (server) to conduct auctions based on constraints and rules entered by the auctioning party.

c. Ross et al (GB 2,315,579A) disclose a system for conducting auctions over a network using an auction computer (server) connected to bidder computers through a GUI.

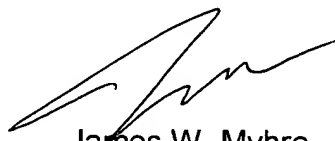
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (571) 272-6724. The fax phone number for Formal or Official faxes to Technology Center 3600 is (571) 273-8300. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (571) 273-6722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-3600.



JWM  
July 28, 2005



James W. Myhre  
Primary Examiner  
Art Unit 3622